

## **REMARKS**

### **Claim Rejections**

Claims 11 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tarng et al. (U.S. 6,039,549). Claims 12-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tarng et al. ('549). Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Tarng et al. ('549). Claims 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tarng et al. ('549) in view of Chang et al. (U.S. 5,527,116).

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

### **Claim Amendments**

By this Amendment, Applicant has canceled claim 12 and has amended claims 11, 18 and 19 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Tarng et al. '549 teaches a volute compressor having a frame (14), first locating blocks (23) and second locating blocks (24) connected to the frame (14). Figure 2 shows a sectional view of the first locating blocks (23) and second locating blocks (24) alternatively connected to the frame (14). Figure 3 is a top view of the same connection. However, neither Figure 2, Figure 3, nor the specification disclose or illustrate a stand ring connected to the first locating blocks and second locating blocks.

Tarng et al. '549 do not teach a stand ring connecting each of the plurality of positioning seats to the block; the plurality of positioning seats and the stand ring are integrated in one piece; each of the plurality of positioning seats has a rest seat corresponding to one of a plurality of grooves on a bottom of the fixed scroll limiting

a descending level of the fixed scroll; nor do Tarnng et al. '549 teach the fixed scroll is located between the plurality of suppressors and each rest seat of the plurality of positioning seats.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Tarnng et al. '549 do not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Tarnng et al. '549 cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

The secondary reference to Chang et al. teaches a mechanism for locating a volute of a scroll compressor and states, column 5 line 66 through column 6 line 2:

The interval 66 is therefore formed between the top of the shoulder 60 of the fixed volute 22 and the bottom of the retaining portion 54 of the locating member 46.

Chang et al. do not teach a stand ring connecting each of the plurality of positioning seats to the block; the plurality of positioning seats and the stand ring are integrated in one piece; each of the plurality of positioning seats has a rest seat corresponding to one of a plurality of grooves on a bottom of the fixed scroll limiting a descending level of the fixed scroll; nor do Chang et al. teach the fixed scroll is located between the plurality of suppressors and each rest seat of the plurality of positioning seats.

Even if the teachings of Tarnng et al. '549 and Chang et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a stand ring connecting each of the plurality of positioning seats to the block; the plurality of positioning seats and the stand ring are integrated in one piece; each of the plurality of positioning seats has a rest seat corresponding to one of a plurality of grooves on a bottom of the fixed scroll limiting a descending level of the fixed scroll; nor does the combination suggest the fixed scroll is located between the plurality of suppressors and each rest seat of the plurality of positioning seats.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Tarng et al. '549 or Chang et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Tarng et al. '549 nor Chang et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

#### **Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claim 12, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.

It is not believed that the foregoing amendments to claim 11 require any further searching and/or consideration on the part of the Examiner, since such amendment merely includes incorporating the language of canceled claim 12 into claim 11. Thus, the Examiner would have inherently searched the subject matter during the previous consideration of claim 12.

Application No. 10/626,798

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: April 11, 2005

By: \_\_\_\_\_

  
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